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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/889,938 | 12/11/2001 | Kenneth Richards | 702-011069 | 4594 |

7590 07/29/2004

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| EXAMINER | |
|---|---|
| MEHTA, ASHWIN D | |
| **ART UNIT** | **PAPER NUMBER** |
| 1638 | |

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Advisory Action | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/889,938 | RICHARDS ET AL. | |
| | Examiner | Art Unit | |
| | Ashwin Mehta | 1638 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 24 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 7 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *24 May 2004*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). *6282004*.

10. ☒ Other: *See Continuation Sheet*

ASHWIN D. MEHTA, PH.D
PATENT EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claims 70 and 71 under 35 U.S.C. 112, 2nd paragraph, appearing on page 3, last full paragraph, of the Office action mailed 24 December 2003.

Continuation of 5. does NOT place the application in condition for allowance because: The claims amendments do not overcome the rejection of claims 62-64, 66, and 69 under 35 U.S.C. 112, 2nd paragraph. Applicants argue that the claims recite specific 5' end and 3' end primers used to obtain the DNA fragments (response, page 6, 2nd full paragraph). However, it remains unclear what the template sequence is from which the DNA fragment is obtained. The claims recite specific nucleotide base numbers, of RNA1 of BNYVV. However, there are multiple isolates of BNYVV. The RNA1 sequences of each of these isolates are not identical. The claims do not make clear which isolate serves as the template sequence. Further, claims 65, 67, 68, and 70-72 would be subject to this rejection, due to the amendments to claims 65 and 68, if the amendments were entered.

The claim amendments do not overcome the rejection of claims 71 and 72 under 35 U.S.C. 112, 2nd paragraph, appearing on page 4, 1st full paragraph, of the Office action mailed 24 December 2004, for claims 70-72. Applicants argue that the claims have been amended to recite the suggested phrases (response, page 6, 2nd full paragraph). However, the article, "The" in line 1 of claims 71 and 72 should have been deleted. As written, there is insufficient antecendent basis for the recitation, "The seeds" in claim 71 and "The vegetatively reproducible structures" in claim 72.

Claim 70 would be rejected under 35 U.S.C. 112, 2nd paragraph for the newly introduced recitation, "said progeny have in their genome at least two copies of the DNA fragment comprising RNA1 of said virus". The recitation indicates that the DNA fragment comprises the entirety of RNA1. However, claim 70 is dependent on claim 68, which indicates that the parent transgenic sugar beet plant copmrises a portion of RNA1, not the entirety of RNA1.

The claim amendments do not overcome the rejection of claims 62-72 under 35 U.S.C. 103(a). Applicants argue that claims 62-64, 66, and 69 recite specific 5' end and 3' end primers used to obtain the DNA fragment, and that the cited references do not teach or suggest the specific nucleotide sequences (response, page 6, 3rd full paragraph). However, the claims still recite the same DNA fragment as the unamended claims. The recitation of the primer sequences do not change the DNA fragment that is encompassed. It would have been obvious to use primer sequences from within a nucleic acid sequence, to amplify that same sequence. The choice of fragment from the RNA1 sequence amounts to an optimization of process parameters, as discussed in the previous Office actions.

Continuation of 10. Other: The foreign patent DE 4446342, submitted with the IDS of June 28, 2004 was not considered because it is not in the English language, and an English language explanation of its teachings was not submitted.